

Application No. 09/776,525  
Amendment Dtd 12/27/2004  
Reply to Office Action Dtd 10/28/2004

Page 8

**REMARKS**

Claims 1-29 have been resubmitted. Claim 1 has been amended. No further Claims have been canceled. Claim 30 has been added.

The Examiner rejected Claims 1-12 and 26-29 under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement. And as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The Examiner further rejected Claims 1-2 and 4-29 under 35 U.S.C. 103(a) as being unpatentable over Shannon (U.S. Pub. No. 2001/0045449) in view of Stephens et al. (U.S. Pat. No. 6,323,782); Claims 4-10, 12, 18, 28, and 29 under 35 U.S.C. 103(a) as being unpatentable over Shannon in view of Stephens et al. in further view of Huxter (U.S. Pub. No. 2002/0103663); Claims 21-22 under 35 U.S.C. 103(a) as being unpatentable over Shannon in view of Stephens et al. in further view of Huang (U.S. Pat. No. 4,520,350)

The Applicant has amended independent Claim 1 to correct a scrivener's error in lines 1-2, so that the phrase "unattended receiving and shipping of goods to a customer-at a location" reads properly. The Applicant has further added new Claim 30, describing another aspect to the method of the invention that has not been previously claimed. Support for new Claim 30 is found in the Applicant's specification, paragraph 0030.

**Specification**

The Examiner has objected to the specification as not supporting the added limitations of Claims 1 and 26, namely, that the specification states that the enclosure can be used for both the pickup and the delivery of goods but

describes them as two separate embodiments, and that the specification lacks a description of how the customer profile has a first delivery service for the deposit of goods and a second delivery service for the pickup of goods. The Examiner suggests that the Applicant delete the new matter.

In the Applicant's response to the first office action, no new matter was added to the specification except with regards to scrivener's errors in labeling elements of the drawings in the specification. The Applicant is thus unsure of just how to respond to this objection, since there is no new matter to delete. The Applicant thus respectfully suggests that the Examiner intended the claim rejections under §112 to support the proposition that the new claims were unsupported by the specification, and the Applicant has dealt with this issue in the following section. If this was not the Examiner's intent, then the Applicant respectfully requests the Examiner to clarify the objection and specify what new matter is to be removed, so that the Applicant can properly reply.

Claim Rejections --- 35 U.S.C. §112

The Examiner has rejected Claims 1-12 and 26-29 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement and that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. According to the Examiner, the specification states that the enclosure can be used for both the pickup and the delivery of goods but describes them as two separate embodiments, and that the specification lacks a description of how the customer profile has a first delivery service for the deposit of goods and a second delivery service for the pickup of goods.

With regards to the first rejection, the Application notes first that the original title of the application was "Secured delivery system for unattended receiving and shipping of parcels and letters" (emphasis added), which clearly indicates that the intent of the Applicant's system is for both receiving and shipping of parcels and letters. The specification states that "The present invention provides a secure delivery system for unattended receiving and shipping of parcels and letters." (Applicant's specification, para. 0008, emphasis added). The method provided for the customer providing a parcel to be picked up by the delivery service is described in Applicant's specification, para. 0030. The specification also recites that "These specific embodiments discussed herein are merely illustrative of specific ways to make and use the invention, and do not delimit the scope or the application of the invention." (Applicant's specification, para. 0027). Additionally, original Claim 13 in the initial submission claimed "A tamper proof enclosure for secure and unattended receipt and shipping of goods comprising: ..." (Claim 13, line 1, emphasis added). It is clear from the original specification that the inventor's intent was to use a secured enclosure for the unattended receipt of goods (Applicant's specification, para. 0028 and 0029).and for the unattended shipment of goods (Applicant's specification, para. 0030). Applicant thus maintains that the limitations added to the claims are supported in the present specification.

In addition, the Applicant is unaware of any restriction in the USPTO rules, customs, or guidelines provided by the Manual of Patent Examining Procedure that would prevent the combination of two embodiments of an invention into the same claim; the Applicant therefore respectfully requests that the Examiner provide such reference so that the Applicant can more properly respond to the rejection.

Regarding the second rejection, the Applicant describes the customer profile as follows: "Customer profile information 15 includes the location and address of the customer 14, the customer's name, a code 17 for operating a tamper-proof enclosure (discussed below) and the location of the tamper-proof enclosure." (Applicant's specification, para. 0028). Also, the customer profile is described thus:

Web page 18 is the Internet-based application used to gather and store customer profile information 15 such as, for example, the address, the code 17 for the tamper-proof enclosure 10 and the location of the tamper-proof enclosure. In additional embodiments of the invention, the customer profile information 15 also contains shipping account information or credit account information to pay for services and goods.

The information provided in the profile is capable of being used by any entity, including one or more delivery services. There is no restriction stated in the specification that the profile information is restricted to a particular delivery service and indeed the information described as being in the profile does not necessarily include information peculiar to a particular delivery service. The customer profile is available to provide information about the customer, and not the delivery service, and therefore the Applicant does not understand the Examiner's rejection that "the specification lacks a description of how the customer profile has a first delivery service for the deposit of goods and a second delivery service for the pickup of goods." The adjectives "first" and "second" as used in the Applicant's Claims 1 and 26 to distinguish between the delivery service delivering the parcel and the delivery service picking up the parcel are typically used in claim construction to clearly delineate between two similarly-named entities as they are used in the claim. There is no restriction in the specification that the two functions, i.e. pickup and delivery, be performed by the same delivery service although they can be.

With regards to Examiner's rejection to Claim 1 being indefinite, Applicant has amended Claim 1 to read "A secure delivery system for unattended receiving and shipping of goods to a customer at a location ...". (Claim 1, lines 1 and 2).

Stephens et al.

Stephens et al. discloses an unattended item delivery system for delivery of parcels to an enclosure having a controlled, secure access. According to the disclosure,

Those involved in the delivery process of an item may commonly fall within three functional groups with respect to one another. These are the receivers, senders and delivery personnel. The receiver may include those who are intended or are expecting to receive an item to be delivered. In the consumer context for example, the receiver may be a customer who initiates the delivery process by placing a product order with a sender. Thus, the sender may be a manufacturer, vendor, seller, or distributor of the item, for example. In response to such product order, the sender may enlist the services of delivery personnel (e.g., couriers, shippers, postal service). It is contemplated that the sender may also function as delivery personnel as well. (Stephens et al., col 1, lines 13-29)

Throughout the disclosure, the use of the term "sender" refers to a vendor or manufacturer that is delivering a parcel to a customer, or "receiver". Stephens et al. describes a system and enclosure that is for the delivery of goods by a sender (vendor or manufacturer) and the retrieval of goods by a receiver (customer). Upon a careful reading of the disclosure of Stephens et al., the Applicant cannot locate a reference in which the roles are reversed, i.e. where the customer fills the role of a "sender" and the vendor or manufacturer fills the role of a "receiver", as is described in Applicant's Claim 1. The action of picking up is consistently made by the customer from the secured enclosure and not by

the delivery service, as when the customer wishes to send a parcel. The Examiner's assertion that Stephens discloses the use of an enclosure that is for the delivery and the retrieval of goods (as in the abstract and in vol. 1, lines 35-37) is incorrect, since the retrieval of goods, as described in the above reference, is made by the customer and not by the delivery service or the sender.

Therefore, with regards to Claims 1-2 and 4-29, since Stephens et al. does not suggest, teach, or disclose the act of the delivery service picking up a parcel from a customer's secured enclosure (but rather discloses the act of the customer picking up or retrieving a package from the secured enclosure), the Applicant respectfully maintains that the Examiner has not made a *prima facie* showing for a §103 rejection, since neither Shannon (by admission of the Examiner) nor Stephens et al. describe, suggest, or teach this limitation.

Since Claims 4-12 all depend upon Claim 1, then if Claim 1 is allowable, then they should also be allowable since they all would depend upon an allowable claim.

Similarly, Claim 13 claims "A tamper-proof enclosure for secure and unattended receipt and shipping of goods for a customer" (Claim 13, lines 1-2, emphasis added). According to the above comments, neither Shannon nor Stephens et al. describes an enclosure for the receipt and shipping of goods for a customer; therefore, the Applicant again asserts that the Examiner has not made a *prima facie* case for a §103 rejection and Claim 13 should be allowable.

Since Claims 14-25 all depend upon Claim 13, then if Claim 13 is allowable, then they should also be allowable since they all would depend upon an allowable claim.

Similarly, Claim 26 claims a method for the delivery and pickup of goods in a tamper-proof enclosure. According to the above comments, neither Shannon nor Stephens et al. describes a method for the receipt and shipping of goods from a customer; therefore, the Applicant again asserts that the Examiner has not made a *prima facie* case for a §103 rejection and Claim 26 should be allowable.

Since Claims 26-29 all depend upon Claim 26, then if Claim 26 is allowable, then they should also be allowable since they all would depend upon an allowable claim.

The Examiner rejected claims 4-10, 12, 18, 28, and 29 under 35 U.S.C. 103(a) as being unpatentable over Shannon in view of Stephens et al. in further view of Huxter. Since by the above arguments presented above maintain that Stephens et al. cannot be used to establish a *prima facie* case for a §103 rejection, then the use of Huxter is moot.

The Examiner rejected claims 21 and 22 under 35 U.S.C. 103(a) as being unpatentable over Shannon in view of Stephens et al. in further view of Huang. Since by the above arguments presented above maintain that Stephens et al. cannot be used to establish a *prima facie* case for a §103 rejection, then the use of Huang is moot.

#### New Claims

New Claim 30 has been added. The Examiner has stated that Shannon fails to disclose that the system and enclosure can also be used for scheduling a pick-up of goods. By the Applicant's arguments presented above, Stephens

Application No. 09/776,525  
Amendment Dtd 12/27/2004  
Reply to Office Action Dtd 10/28/2004

Page 15

et al. does not disclose a system and enclosure that can be used for scheduling and a pick-up of goods. Furthermore, neither Huang nor Huxter discuss the pick-up of goods from the secured enclosure by a delivery service. Therefore, the Applicant believes that new Claim 30 should be allowable.

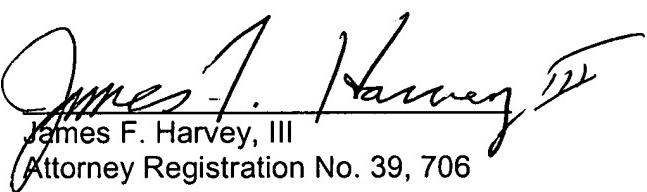
### CONCLUSION

Reconsideration and withdrawal of the Office Action with respect to Claims 1-29 and allowance of Claims 1-30 is respectfully requested.

In the event the examiner wishes to discuss any aspect of this response, please contact the attorney at the telephone number identified below.

Respectfully submitted,

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